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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
PHAM, CHRYSTINE

ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/970,134	NGUYEN ET AL.
	Examiner	Art Unit	
	Chrystine Pham	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the Amendment filed on January 10th 2005. Claims 5, and 11 have

been amended. Claims 1-38 are presented for examination.

Response to Amendment

2.   In view of the amendment of specification to include double-spacing, objection to the specification

is hereby withdrawn.

3.   In view of the amendment of claim 5 to include a consistent terminology set forth in claim 3 ("data

storage unit"), objection of claim 5 is hereby withdrawn.

4.   In view of the amendment of claim 11 to correct the typographical error "sadi", objection of claim

11 is hereby withdrawn.

5.   The affidavit/declaration filed on January 10th 2005 under 37 CFR 1.131 has been considered but

is ineffective to overcome the Rosen (US 2003/0048473) reference.

        The Rosen reference is a U.S. patent or U.S. patent application publication of a pending

or patented application that claims the rejected invention. An affidavit or declaration is

inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable

invention, see MPEP § 2306. If the reference and this application are not commonly owned, the

reference can only be overcome by establishing priority of invention through interference

proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If

the reference and this application are commonly owned, the reference may be disqualified as

prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

        The evidence (i.e., Exhibit 1) submitted is insufficient to establish a conception of the

invention prior to the effective date of the Rosen reference. While conception is the mental part

of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a

complete disclosure to another. Conception is more than a vague idea of how to solve a

problem. The requisite means themselves and their interaction must also be comprehended.

See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

In view of the foregoing discussion, claim rejections under U.S.C §102(e) and U.S.C §103(a)

established in the Office Action dated July 15th 2004 are considered proper and maintained.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b),
by another filed in the United States before the invention by the applicant for patent or (2) a
patent granted on an application for patent by another filed in the United States before the
invention by the applicant for patent, except that an international application filed under the treaty
defined in section 351(a) shall have the effects for purposes of this subsection of an application
filed in the United States only if the international application designated the United States and
was published under Article 21(2) of such treaty in the English language.

7.   Claims 16-17, 19, 35-36, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by

Rosen (US 2003/0048473), hereinafter *Rosen.*

        As per claim 16, *Rosen* teaches a method of providing device software to a client

machine of a network, comprising the steps of:

        o   storing the device software on at least one network peripheral device (e.g., see

              Abstract, Fig.1 *printer driver 114 & memory 112* & associated text, Fig.4 *printer 402,*

              404 & associated text) disposed in communication (e.g., Fig.4 & associated text, par.

              [0029] line 8-10, Fig.2 & associated text, par. [0032] line 9-11) on the network (e.g.,

              Fig.4 *network 406* & associated text);

- o communicating data representative of a presence of the device software (e.g., FIG.4A *74 & 76*, FIG.4B *78*, col.1 : 18-20 & 47-52, col.3 : 10-13) to the client machine (e.g., Fig.4 *computer 408* & associated text) of an end-user (e.g., par. [0009] line 4-5);

- o establishing data communication between said at least one network peripheral device and the client machine in accordance with a prompt generated by the client machine (e.g., par. [0011] line 1-4); and

- o downloading the device software from said at least one network peripheral device to said client machine in accordance with said prompt (e.g., par. [0038] line 9-11).

As per claim 17, *Rosen* teaches the method of claim 16, wherein the step of communicating occurs in response to said end-user sending a print request to said at least one network peripheral device which is a network printer (e.g., par. [0038] line 1-3).

As per claim 19, *Rosen* teaches the method of claim 16, further comprising the step of uploading the device software to said at least one network peripheral device by an administrative user so that said end-user can download selected ones of components of the device software in the step of downloading (e.g., par. [0038] line 11-14, Fig.5 & associated text, par. [0040] line 1-11).

As per claim 35, *Rosen* teaches an apparatus for providing peripheral software to a client machine of a network, comprising the steps of:

- o at least one network peripheral disposed in communication (e.g., Fig.4 & associated text, par. [0029] line 8-10, Fig.2 & associated text, par. [0032] line 9-11) on the network (e.g., Fig.4 *network 406* & associated text), said at least one network peripheral having a storage unit for storing the peripheral software device (e.g., see

Abstract, Fig.1 *printer driver 114 & memory 112* & associated text, Fig.4 *printer 402, 404* & associated text);

o   wherein data is communicated from said at least one network peripheral to the client machine (e.g., Fig.4 *computer 408* & associated text) of an end-user (e.g., par. [0009] line 4-5) that is representative of a presence of the peripheral software (e.g., FIG.4A *74 & 76*, FIG.4B *78*, col.1 : 18-20 & 47-52, col.3 : 10-13);

o   wherein data communication is established between said at least one network peripheral and the client machine in accordance with a prompt generated by the client machine (e.g., par. [0011] line 1-4);

o   wherein the peripheral software is downloaded from said at least one network peripheral to said client machine in accordance with said prompt (e.g., par. [0038] line 9-11).

As per claims 36 and 38, they recite limitations which have been addressed in claims 17 & 19 respectively, therefore, are rejected for the same reasons as cited in claims 17 & 19.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1-15, 18, 20-34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rosen* as applied to claims 16-17, 19, 35-36, and 38 above, in further view of Slivka et al. (US 6,256,668), hereinafter *Slivka et al.*

As per claim 1, *Rosen* teaches a method of providing device software from a network,

comprising the steps of:

- o providing communications (e.g., Fig.4 & associated text, par. [0029] line 8-10, Fig.2 &

  associated text, par. [0032] line 9-11) via the network (e.g., Fig.4 *network 406* &

  associated text)between a client machine (e.g., Fig.4 *computer 408* & associated

  text*)* disposed on the network and at least one network peripheral device (e.g., see

  Abstract, Fig.1 *printer driver 114 & memory 112* & associated text, Fig.4 *printer 402,*

  404 & associated text), said client machine associated with an end-user (e.g., par.

  [0009] line 4-5);

- o notifying the client machine of the availability of the device software (e.g., FIG.4A *74*

  & 76, FIG.4B *78*, col.1 : 18-20 & 47-52, col.3 : 10-13) in response to a connection

  request to said at least one network peripheral device (e.g., par. [0011] line 1-4);

- o downloading said selected components of the device software from said at least one

  network peripheral device to the client machine (e.g., par. [0038] line 9-11).

Rosen fails to teach the manual selection of one or more components of the device

software for download by the end-user. *Slivka et al.* teach a method of providing device software

(e.g., col.1 line 31-33) to client machine (e.g., FIG.2 *user computer 34* & associated text) from a

network (e.g., FIG.2 *36, server 46* & associated text) comprising the step of manually selecting

(by end-user) for download one or more components of the device software (e.g., col.5 : 55-65,

FIG.4B *86* & associated text, col.8 : 43-47 & 57-59). It would have been obvious to one of

ordinary skill in the pertinent art, at the time of applicant's invention, to modify the teaching of

Rosen to allow the manual selection of device software components by end-user, since doing so

will ensure that the end-user has the ultimate control over data transmitted to client machine from

other machines/devices connected thereto.

As per claims 2, 8, and 15, they recite limitations which have been addressed in claims

17 and 19 above, therefore, are rejected for the same reasons as cited in claim 17 and 19.

As per claim 3, *Rosen* as modified by *Slivka et al.* teaches the method of claim 1, wherein said at least one network peripheral device in the step of providing is a network printer having a data storage unit (e.g., Fig.1 *memory 112* & associated text) associated therewith on which the device software is stored (e.g., Fig.1 *printer driver 114* & associated text).

As per claim 4, *Rosen* as modified by *Slivka et al.* teaches the method of claim 3, wherein said data storage unit is a hard disk drive internal to said network printer of the providing step (e.g., par. [0028] line 7-9).

As per claim 5, *Rosen* as modified by *Slivka et al.* teaches the method of claim 3, wherein said mass storage unit is a non-volatile memory internal to said network printer of the providing step (e.g., par. [0028] line 3-5).

As per claim 6, *Rosen* as modified by *Slivka et al.* teaches the method of claim 1, wherein said selected components of the device software in the step of downloading include a device driver compatible with said at least one network peripheral device (e.g., par. [0004] line 4-9).

As per claim 7, *Rosen* as modified by *Slivka et al.* teaches the method of claim 1, wherein said selected components of the device software in the step of downloading include a device driver and utility software associated with said at least one network peripheral device (e.g., par. [0043] line 1-6).

As per claim 9, although *Rosen* as modified by *Slivka et al.* is silent on the network peripheral device being network facsimile machine in particular, though it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the facsimile machine as one of peripheral devices since facsimile machines, besides printer

machines, scanners, etc., were well-known network peripheral devices which depended on

associated device drivers to be operable.

As per claim 10, *Rosen* as modified by *Slivka et al.* teaches the method of claim 1,

wherein said at least one network peripheral device in the step of providing is a network multi-

function machine providing a plurality of capabilities (e.g., par. [0003] line 1-8).

As per claim 11, *Rosen* as modified by *Slivka et al.* teaches the method of claim 1, further

comprising the step of installing selected components of the device software on said client

machine (e.g., FIG.4B *92 & 94* & associated text, col.2 : 53-55) to facilitate accessing functionality

of said at least one network peripheral device (e.g., col.1 : 35-43).

As per claim 12, *Rosen* as modified by *Slivka et al.* teaches the method of claim 11,

wherein the step of installing occurs automatically after said end-user of said client machine

downloads said selected components of the device software (e.g., col.3 : 22-23).

As per claim 13, *Rosen* as modified by *Slivka et al.* teaches the method of claim 11,

wherein said end-user of the client machine manually initiates the step of installing after

downloading said selected components of the device software (e.g., col.10 : 1-3 & 8-17).

As per claim 14, *Rosen* as modified by *Slivka et al.* teaches the method of claim 11,

wherein said end-user installs said selected components of the device software on said client

machine at a time substantially later than the step of downloading (e.g., col.10 : 1-3 & 8-17).

As per claim 15, *Rosen* as modified by *Slivka et al.* teaches the method of claim 1, further

comprising the step of uploading the device software to said at least one network peripheral

device by an administrative user for subsequent downloading by said end-user (e.g., FIG.7 & associated text, col.13 : 11-15).

As per claim 18, it recites limitations which have been addressed in claim 1 above, therefore, is rejected for the same reasons as cited in claim 1.

As per claim 20, *Rosen* teaches an apparatus for providing peripheral software from a network, comprising:

- o a client machine (e.g., Fig.4 *computer 408* & associated text) of an end-user (e.g., par. [0009] line 4-5) disposed on the network (e.g., Fig.4 *network 406* & associated text), and operable to obtain a service provided therein; and

- o at least one network peripheral disposed on the network for providing said service (e.g., see Abstract, Fig.1 *printer driver 114* & *memory 112* & associated text, Fig.4 *printer 402, 404* & associated text);

- o wherein said at least one network peripheral notifies said client machine of the availability of the peripheral software (e.g., FIG.4A *74* & *76*, FIG.4B *78*, col.1 : 18-20 & 47-52, col.3 : 10-13) in response to said client machine requesting said service of said at least one network peripheral (e.g., par. [0011] line 1-4);

Rosen fails to teach the apparatus wherein one or more components of the device software are manually selected for download by the end-user. *Slivka et al.* teach a apparatus for providing device software (e.g., col.1 line 31-33) to client machine (e.g., FIG.2 *user computer 34* & associated text) from a network (e.g., FIG.2 *36, server 46* & associated text) comprising the end-user manually selects for download one or more components of the peripheral software (e.g., FIG.4B *86* & associated text, col.5 : 60-64, col.8 : 56-59). It would have been obvious to one of ordinary skill in the pertinent art, at the time of applicant's invention, to modify the teaching of *Rosen* to allow the manual selection of device software components by end-user, since doing so will ensure

that the end-user has the ultimate control over data transmitted to client machine from other

machines/devices connected thereto.

As per claims 21-26, and 28-34, they recite limitations which have been addressed in

claims 2-7, and 10-15, therefore, are rejected for the same reasons as cited in claims 2-7, and 10-

15.

As per claim 27, *Rosen* as modified by *Slivka et al.* teaches the apparatus of claim 20,

wherein said end-user of said client machine accesses said at least one network peripheral to

download the peripheral software via a user interface (e.g., FIG.4B *user update application 78 & 82*

& associated text).

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth
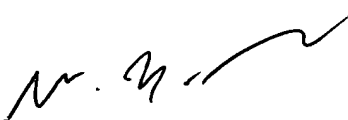
in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS

from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the

date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory

period for reply expire later than SIX MONTHS from the mailing date of this final action.

11.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Chrystine Pham whose telephone number is 571-272-3702. The examiner can

normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on 571-272-3695. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system,

see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CP
May 9, 2005

WEI Y. ZHEN
PRIMARY EXAMINER